

PATENT

Case Docket No. GNE.3030R1C10

Date: June 27, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Desnoyers et al.
Appl. No. : 10/035,977
Filed : December 26, 2001
For : SECRETED AND
TRANSMEMBRANE
POLYPEPTIDES AND
NUCLEIC ACIDS ENCODING
THE SAME

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June 27, 2002

(Date)

AnneMarie Kaiser, Reg. No. 37,649

Examiner : Unknown

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United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

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LICENSING & REVIEW

Dear Sir:

Enclosed for filing in the above-identified application is:

- (X) Request for Reconsideration and Withdrawal of Notice Requesting Property Rights Statement.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required, now or in the future, or credit any overpayment, to Account No. 11-1410.

AnneMarie Kaiser
Registration No. 37,649
Attorney of Record

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Desnoyers et al.
App1. No. : 10/035,977
Filed : December 26, 2001
For : SECRETED AND
TRANSMEMBRANE
POLYPEPTIDES AND
NUCLEIC ACIDS ENCODING
THE SAME
Examiner : Unknown

CERTIFICATE OF FAX TRANSMISSION

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June 27, 2002

(Date)

AnneMarie Kaiser, Reg. No. 37,649

REQUEST FOR RECONSIDERATION AND WITHDRAWAL OF NOTICE
REQUESTING PROPERTY RIGHTS STATEMENT

Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Attn: LICENSING AND REVIEW

Dear Sir:

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Applicants received a Notice mailed April 26, 2002, requesting a Department of Energy property rights statement under 42 U.S.C. § 2182. A copy of the Notice is attached.

The subject matter in the above-referenced application is not "useful in the production or utilization of special nuclear material or atomic energy." Instead, the subject matter of the above-referenced application relates to the identification and isolation of novel nucleic acids and to the recombinant production of novel polypeptides.

The subject matter in the above-referenced invention was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy Research and Development Administration or the Department of Energy.

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App1. No. : 10/035,977
Filed : December 26, 2001

In addition, the invention was not made (conceived or first actually reduced to practice) under nor is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

The inventors conceived this invention while employed by Genentech, Inc. The invention was made during working hours and with the use of facilities, equipment, materials, funds, information, and services of Genentech, Inc. The entire right, title, and interest in said invention is assigned to Genentech, Inc.

Applicants therefore request that the Notice and requirement for a property rights statement be reconsidered and withdrawn and that the application be passed to Group Art Unit 1646 for examination.

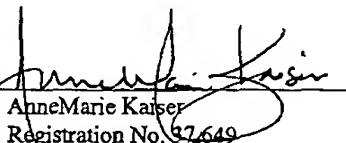
The undersigned attorney declares further that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

June 27, 2002

By:


AnneMarie Kaiser
Registration No. 97,649
Attorney of Record
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(619) 235-8550

S:\DOCS\MTM\MTM-2804.DOC\062702

Louis J. Knobbe
Don W. Martens
Gordon H. Olson
James R. Bear
Darrill L. Olson
William B. Bunker
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Halleary K. De Meritler
Irfan A. Latouf
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Sharon S. Ng
Mark J. Gallagher, Ph.D.
David G. Jankowski, Ph.D.
Brian C. Horne
Payson J. LeMellieur
Shelia K. Swatow
Ben A. Kalzenellenbogen
Linda H. Liu

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

550 West C Street
Suite 1200
San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176
knob.com

Jeffrey S. Ellsworth
Andrew N. Merckel, Ph.D.
Douglas T. Hudson
David L. Hauser
Kara D. Larson
James F. Harkenhoff
Scott L. Murray
Roger S. Shang
Andrew M. Douglas
Marc T. Morley
Sallma A. Merani, Ph.D.
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Kyle F. Schuster
Raphael A. Gullerrez
Demian K. Jackson
Nathan A. Engels

Of Counsel
Jerry R. Soller
Paul C. Steinhardt
Japanese Patent Atty
Katsuhiko Arai
Tomohisa Sugiyama
European Patent Atty
Marius Heilebrandt
Korean Patent Atty
Mincheol Kim
Heungsoo Choi

Solicitor (England & Wales)
J. David Evers

Scientists & Engineers
(Non-Lawyers)

Raimond J. Saleninks
Khurram Rahman, Ph.D.
Jennifer A. Haynes, Ph.D.
Tommy Y. Nagata
Che S. Charekila, Ph.D.
James W. Ausley
Jenifer Hayes
Kirk E. Pastorfan, Ph.D.
Charles T. Ridgely
Boony Young, Ph.D.
Connie C. Tong, Ph.D.
Suzanne G. Jepson, Ph.D.
David K. Wiggins
Megan M. McCoy
Hira M. Brand
Catherine M. Sanders
Jeffrey A. Hopkins
Thitany C. Miller
James W. Chang, Ph.D.
Marina L. Gorder, Ph.D.
Ed Desjardins, Ph.D.
W. Frank Dauter
Lang J. McHardy
Kates J. Lecker
Chris B. Wiestberg, Ph.D.
Eric B. Ives, Ph.D.
David C. Weber

* A Professional Corporation
† Also Barrister At Law (S.C. & N.C.)
** U.S. Patent Agent

June 27, 2002
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TO: United States Patent and Trademark Office
ATTENTION: LICENSING AND REVIEW
FACSIMILE NO.: 703-305-6384
FROM: AnneMarie Kaiser, Reg. No. 37,649
CLIENT CODE: GNE.3030RIC10
APP. NO.: 10/035,977
PAGES: 4 (INCLUDING THIS SHEET)

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620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
Tel 949-706-9004
Fax 949-706-9502

201 California Street
Suite 1150
San Francisco CA 94111
Tel 415-954-4114
Fax 415-954-4111

1900 Avenue of the Stars
Suite 1425
Los Angeles CA 90067
Tel 310-551-3450
Fax 310-551-3450

3403 Tenth Street
Suite 100
Riverside CA 92501
Tel 951-781-8221
Fax 951-781-4507

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Ginger R. Dreger
Knobbe Martens Olson & Bear
Suite 1150
201 California Street
San Francisco CA 94111

In re Application of:
Desnoyers et al:
For Serial No. 10/035,977

DECISION ON
REQUEST FOR
RECONSIDERATION

Filed: December 26, 2001

For: **SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC
ACIDS ENCODING THE SAME**

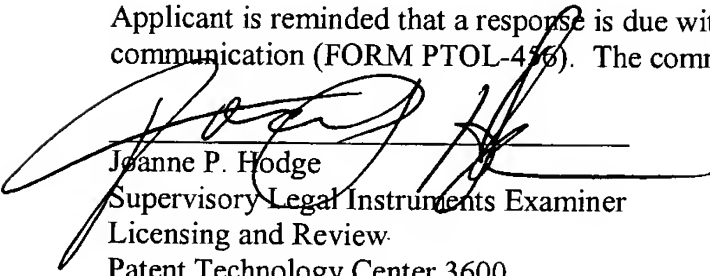
This is a decision on the REQUEST FOR RECONSIDERATION filed June 19, 2002 responding to the communication (FORM PTOL-456) mailed May 21, 2002.

The request has been **DENIED** to the extent indicated below.

42 U.S.C. 2182 states in part "... useful in the production or utilization of special nuclear material or atomic energy". A review of the application file history reveals among other things the use of a radioactive isotope "³²P" as disclosed in at least page 119 of the instant specification. Therefore under the directions from the Department of Energy (DOE) this application has been made available to them under 42 U.S.C. 2182 since the following subject matter relates to at least one of the following:

- G. Materials, apparatus and methods concerning isotope and/or radioactive source technology including those utilizing (including responsive to) radioactive sources in:
 - a. Life Sciences such as medicine (diagnostic and therapeutic), ecology, disease and pest control, animal husbandry, etc.
 - b. Industrial processes such as food processing, sterilization, polymer production, etc.
 - c. Investigations of the environment or the earth
- H. Instruments employing a radioactive source and/or radioactivity detector in the operation thereof.

Applicant is reminded that a response is due within forty-five days of the mailing date of the communication (FORM PTOL-456). The communication having been mailed May 21, 2002.


Joanne P. Hodge
Supervisory Legal Instruments Examiner
Licensing and Review
Patent Technology Center 3600